

Remarks

Applicant thanks the examiner for the courtesies extended during the telephonic interview held on September 10, 2003. During this interview, U.S. Patent No. 5,486,593 ("the '593 patent") and possible amendments to claim 1 were discussed.

In light of that interview, applicants propose the foregoing amendments and following remarks. After entry of the foregoing amendments, claims 1, 3-22 and 37 remain pending. Claims 2 and 23-36 have been cancelled. Claims 1 and 16 have been amended to indicate that the solid core is comprised of a metal or an alloy. Support for this amendment may be found at page 8, lines 27-28 of the specification. Claim 37 has also been amended to clarify the claimed invention.

Rejection Under 37 U.S.C. §102

Claims 1-5, 11-14, 16, 17, 20 and 21 stand rejected under §102(b) as being anticipated by the '593 patent. The Manual of Patent Examining Procedure ("MPEP") §2131 states that, in order to anticipate a claim, a reference must teach every element of the claim:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1222, 1236 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989)."

Applicant respectfully submits that the '593 patent fails to disclose each and every element of the claimed invention. The Office Action states that the '593 patent discloses a bioabsorbable and/or biodegradeable solid fiber coated with a polymer to form a sheath-core structure.

Applicant has amended claims 1 and 16 to include the limitation "wherein the solid core comprises a metal or an alloy." Applicant respectfully submits that the '593 patent does not disclose a filament comprising a solid core...wherein the solid core comprises a metal or

an alloy (language of claim 1 underlined) or a method of making a filamentary structure for introducing an agent into a living host...wherein the solid core comprises a metal or an alloy (language of claim 16 underlined).

Because the '593 patent fails to teach this claim limitation, it cannot anticipate claims 1 and 16. Applicant therefore requests that this rejection be withdrawn.

Claims 3-5, 11-14, 17, 20 and 21 are dependent from claim 1 or claim 16 and therefore are not anticipated by the '593 patent for at least the same reasons. Applicant respectfully submits that the claims as amended are in condition for allowance and requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. §103

Claims 1-22 and 37 stand rejected under §103(a) as being unpatentable over the '593 patent in view of U.S. Patent No. 6,027,744 ("the '744 patent") as applied to claims 6 and 7 and in view of U.S. Patent No. 4,104,195 ("the '195 patent") as applied to claims 18 and 19.

MPEP §2141.03 states:

"To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F2d 1382, 165 U.S.P.Q. 494, 496 (CCPA 1970).

Applicant respectfully submits that the Office Action has failed to set forth a *prima facie* case of obviousness, as the combined references fail to disclose all the limitations of the claimed invention.

As discussed above, claims 1 and 16 have been amended to include the limitation "wherein the solid core comprises a metal or an alloy." The '593 patent does not teach or suggest the claimed filamentary structure (claim 1) or the claimed method of making a filamentary structure (claim 16).

The examiner has cited two additional references in support of the obviousness rejection. Applicant respectfully submits that these references do not cure the deficiencies of the '593 patent as discussed above. The '744 patent, which is cited as disclosing living hair follicles incorporated in a biocompatible support structure, does not disclose a solid core comprised of a metal or an alloy. The '195 patent, which is cited as disclosing foam forming agents that do not give off corrosive, discoloring, unpleasant smelling or toxic decomposition products, does not disclose the claimed solid core either. As a result, all of the elements of claims 1 and 16 are not taught or suggested by the cited references either alone or in combination. Thus, claims 1 and 16 more than meet the requirements of 35 U.S.C. §103.

Because the remaining claims are dependent on either claim 1 or claim 16, they are patentable over the cited references for at least the same reasons. Applicant, therefore, respectfully requests that the rejection be withdrawn.

CONCLUSION

Applicant submits that the claims as amended are in condition for allowance and earnestly solicits a Notice of Allowance. Should the examiner have any questions, she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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